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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/229,704	01/13/1999	FRANCIS R. WALDMAN	1298/0E751	5569
7590	01/07/2004		EXAMINER	
Joseph B Ryan Ryan Mason & Lewis LLP 90 Forest Avenue Locust Valley, NY 11560			TRAN, THIEN D	
			ART UNIT	PAPER NUMBER
			2665	
DATE MAILED: 01/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/229,704	WALDMAN, FRANCIS R.
Examiner	Art Unit	
Thien D Tran	2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 November 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 3-8 is/are allowed.

6) Claim(s) 1, 2, 9-17 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . 6) Other: ____ .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 9-17 are rejected under 35 U.S.C. 102(e) as being participated by Kaplan et al (U.S Patent No 6,141,339).

Regarding claims 1, 9, Kaplan discloses a method for interconnecting a MUX 120 (calling party asynchronous transfer mode system) having a calling party host 102 with MUX 124 having a called party host 110 (called party asynchronous transfer mode system) having a SONET 130 and 132 (an intermediate switching asynchronous transfer mode networks) and a service node (border node) associated with each asynchronous transfer mode system comprising (figure.1, col.3 lines 5-55):

routing a call from said calling party host to the called party host over the intermediate switching asynchronous transfer mode network based on an ATM domain addressing scheme that independent of an addressing scheme of the asynchronous transfer mode systems (figures 11-15, col.13 lines 35-65).

Regarding claims 2, 15, 16, Kaplan discloses a method comprising:

substituting at the border node of the calling party asynchronous transfer mode system in a called party address information element an intermediate switching asynchronous transfer mode network address of the border node of the called party asynchronous transfer mode system for the asynchronous transfer mode system address of the called party host; and

routing the call over the intermediate switching asynchronous transfer mode network from the border node of the calling party asynchronous transfer mode system to the border node of the called party asynchronous transfer mode system based on the intermediate switching asynchronous transfer mode network address in the called party address information element (figures 11-15).

Regarding claim 10, Kaplan discloses that switch border nodes are asynchronous transfer mode switches. See figure 1.

Regarding claims 11, 13, Kaplan discloses that calling party asynchronous transfer mode system comprises a calling party host directly connected to calling party border node. See col.5 lines 15-50.

Regarding claims 12, 14, Kaplan discloses a calling party asynchronous transfer mode system comprises:

a calling party host; and
at least one calling party non-border node connected between said calling party host and said calling party border node. See col.4 lines 30-55.

Regarding claim 17, Kaplan discloses a method for interconnecting calling party asynchronous transfer mode system having a calling party host 102 and called party asynchronous transfer mode system having a called party host 110 SONET (an intermediate switching asynchronous transfer mode network) and a Service node 140 (border node) associated with each asynchronous transfer mode system comprising (col.5 lines 10-55):

routing a call from said calling party host to the called party host over the intermediate switching ATM network addressing scheme that is recognized by the border node and independent of an addressing scheme of the asynchronous transfer mode systems (figures 11-15);

generating at the calling party host a message specifying the ATM system address of the called party host in a called party address information element; substituting at the calling party border node in the called party address information element the intermediate switching ATM network address of the called party border node for the ATM system address of the called party host;

transmitting the call over the intermediate switching ATM network to the called party border node based on the intermediate switching ATM network address of the called party border node in the called party address information element;

generating at the called party border node a message specifying in the called party address information element the ATM system address of the called party host; and

routing the call to the called party host based on the asynchronous transfer system address of the called party host in the called party address information element. See figures 11-15.

Allowable Subject Matter

3. Claims 3-8 are allowed.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Thien Tran whose telephone number is (703) 308-4388. The examiner can normally be reached on Monday-Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (703) 308-6602. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Thien Tran



ALPUS H. HSU
PRIMARY EXAMINER